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10/599,118	09/20/2006	Jun Masuda	351917-P0001	4453
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DLA PIPER LLP US P. O. BOX 2758 RESTON, VA 20195			SAVAGE, JASON L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,118	Applicant(s) MASUDA ET AL.	
	Examiner JASON L. SAVAGE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090112, 20081119, 20081027</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

The references on the IDS' filed as papers 20090112 and 20081027 have references which were not initialed since they had previously been cited on the PTO-892 in the office action mailed 6-27-08.

Election/Restrictions

Newly submitted claims 14-19 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1, 3-5 and 7-13, drawn to an article and method of forming.
Group II, claim(s) 14-19, drawn to a method of using the formed article.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: While the invention of Group I recites the article formed may be employed in a method such as a machine for casting an article from molten aluminum alloy such as claimed in the invention of Group II, the invention of Group I is not limited to being used in a method for casting molten aluminum alloy and could be employed in a method using an alternate metal such as pure aluminum or another metal including magnesium or titanium. As such the claimed groups are not linked to form a single general inventive concept.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 14-19 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-5 and 7-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-10 of copending Application No. 11/565,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application '771 recites a composite material for a die casting machine part comprising a steel pipe base, a Ni alloy layer formed on the steel base, and titanium carbide particles bonded to the surface of the Ni alloy layer (claim 1). Regarding the limitation in the claims that the casting metal is to

be molten aluminum, it would have been obvious to have used the claimed composite material for die casting for a variety of materials including aluminum with a reasonable expectation of success.

Regarding claims the claim limitations in claims 1, 5 and dependent claims 3-4 and 7-8, Application'771 recites the same claim limitations such as the TiC particles are not fully covered, gaps between the particles are filled with the claimed fine ceramic materials and the Ni alloy is the same composition as claimed (claims 2-4).

Regarding claim 9, Application'771 recites the composite material may be used as a sleeve part (claim 1).

Regarding claims 10-11, Application'771 recites the same limitations of forming the contact member including forming Ni alloy layer on steel base, burying the contact member body in TiC powder, vacuum heating to bond the powder and Ni layer, subsequently applying a slurry of ceramics (claims 8-9).

Regarding claim 12, Application'771 recites a TiC particle size between 10 to 500 microns. However, where the only difference between a claim and the prior art is one of relative dimensional differences and there is no showing that the claimed device and the prior art would perform any differently, the claimed device is not patentably distinct from the prior art. *Gardner v. TEC System, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

Regarding claim 13, Application'771 does not claim the Ni alloy layer is formed by thermal spraying, however it would have been obvious to deposit the claimed layer

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by any conventional deposition process including thermal spraying with a reasonable expectation of success.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Darrow (US 4,996,114).

Regarding claims 1 and 5, Darrow teaches a composite metal material comprising a steel base substrate, a Ni alloy layer formed on the steel base, and titanium carbide particles bonded to the surface of the Ni alloy layer which partly protrude from the surface of the Ni alloy layer (col. 1, ln. 60-68). Regarding the limitation that the material is a machine part for a casting machine for casting an article from molten aluminum alloy, the recited claim limitations are drawn to an intended use which is not considered a patentably distinguishing limitation since Darrow teaches the same structure as what is claimed. See Ex parte Masham 2 U.S.P.Q.2d 1647, 1648. In re Thuau 135 F.2d 344, 47 U.S.P.Q. 324. Application of Hack, 245 F.2d.246, 114 U.S.P.Q. 161.

Regarding the limitation that the expected TiC particles repel molten aluminum alloy, since the particles are of the same material and the material has the same surface structure, it would be considered to be just as capable of repelling molten aluminum as the material claimed.

Regarding claim 9, the surface of the composite of Darrow would be just as suitable to be placed in direct contact with a molten aluminum alloy since it is made of the same materials and has the same structure as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US 4,996,114).

Darrow teaches what is set forth above but is silent to burying the nickel coated steel base in TiC powder. However, it would have been within the purview of one of ordinary skill to have selected any suitable method of applying the TiC particles to the coated metal material surface with a reasonable expectation of success. Absent a teaching of the criticality or showing of unexpected results from the claimed method step, it would not provide a patentable distinction over the prior art.

Darrow is also silent to the step of heating the coated article in a heating oven to generate a liquid phase to thereby bond the TiC particles. However joining materials by heating in a protective atmosphere such as vacuums are known and thus would have been obvious.

Regarding claim 12, Darrow is silent to the average particle diameter. However, where the only difference between a claim and the prior art is one of relative dimensional differences and there is no showing that the claimed device and the prior art would perform any differently, the claimed device is not patentably distinct from the prior art.

Claims 1, 3, 5, 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al (JP 08-229657 English Machine Translation) in view of Negishi (JP 2001-300711 English Machine Translation)

Nakayama teaches a composite material for a die casting machine part comprising a steel base substrate, a Ni alloy layer plated on the steel base, and carbide particles bonded to the surface of the Ni alloy layer (par[0010]). Nakayama further teaches that the machine part for this the composite material is to be used in an aluminum die-casting wherein the material will contact hot molten aluminum metal (par[0001]).

Regarding the limitation that the carbide particles are partly exposed on the surface of the Ni layer, Nakayama does not exemplify an embodiment with the claim limitation. However, Nakayama teaches that it is desirable to form a concentration gradient of carbide particles at the surface of the composite material which contacts the

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molten aluminum so as to provide greater hardness and corrosion resistance to the molten metal (par[028]). As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the surface having a high concentration of carbide particle so as to provide the composite with improved hardness and corrosion resistance. It is the position of the Examiner that a high concentration at the surface would result in some carbide particles being partially exposed. In the alternative, it would have been obvious to have formed a surface having primarily or consisting of the carbide particles with a reasonable expectation of success of providing the composite with even greater hardness and abrasion resistance to achieve a higher corrosion resistance for the composite.

Regarding the limitation that the carbide powders is titanium carbide, Nakayama is silent to the carbide particles being titanium carbide. Negishi teaches a composite material for an aluminum die casting machine part which may comprising a steel base substrate or a Ni alloy layer having a tunic layer made of high hardness materials such as titanium carbide which provides high abrasion resistance to the composite (par[0001-0002]). As such, it would have been obvious to one of ordinary skill in the art to have modified the composite material part of Nakayama by following the teachings of Negishi such as by employing titanium carbide as the carbide particulate material with a reasonable expectation of success.

Regarding claims 3, 7 and 11, Nakayama teaches that ceramic particles such as oxides of alumina and zirconia may be added in combination with the TiC particles which results in outstanding abrasion resistance (par[0026-0027]). As such, it would

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have been obvious to have added ceramic powders such as those claimed in order to provide the material composite with outstanding abrasion resistance. Regarding the limitation that the ceramic fills gaps in the TiC particles, it is the position of the Examiner that the ceramics of Nakayama would fill in some gaps of the TiC particles and thus would meet the claim limitations.

Regarding claim 9, the article of Nakayama as modified by Negishi would meet the claim limitation as being drawn to a die casting machine for aluminum alloys and thus would have a surface which would be in direct contact with molten aluminum

Regarding claim 10, the references are silent to the limitation that the nickel coated steel base is buried in TiC powder. However, it would have been within the purview of one of ordinary skill to have selected any suitable method of applying the TiC particles to the coated metal material surface with a reasonable expectation of success. Absent a teaching of the criticality or showing of unexpected results from the claimed method step, it would not provide a patentable distinction over the prior art.

The prior art is also silent to the step of heating the coated article in a heating oven to generate a liquid phase to thereby bond the TiC particles. However joining materials by heating in a protective atmosphere such as vacuums are known and thus would have been obvious.

Regarding claim 12, the prior art is silent to the average particle diameter. However, where the only difference between a claim and the prior art is one of relative dimensional differences and there is no showing that the claimed device and the prior

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art would perform any differently, the claimed device is not patentably distinct from the prior art.

Claims 4, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al (JP 08-229657 English Machine Translation) in view of Negishi (JP 2001-300711 English Machine Translation) as applied to claims 1, 3, 5, 7 and 9-12 above, further in view of Honma et al (JP 2001-342530).

The prior art teaches what is set forth above; however it does not exemplify the claimed nickel alloy. Honma teaches a dies casting machine having a steel substrate which an Ni-alloy which is corrosion and wear resistant bonded thereto (claims 5-12) Honma further teaches that the nickel alloy is an alloy containing B, Mo, Si and C which overlap the ranges claimed. As such, it would have been obvious one of ordinary skill in the art at the time of the invention to have modified the invention of Nakayama and Negishi by utilizing the NiBMoC alloy of Honma with a reasonable expectation of success.

Regarding the limitation in claim 13, the prior art is silent to the claimed nickel alloy being deposited by thermal spraying. However, it would have been obvious to deposit the claimed layer by any conventional deposition process including thermal spraying with a reasonable expectation of success.

Response to Arguments

Applicant's arguments filed 10-27-08 have been fully considered but they are not persuasive.

Darrow Reference

Applicant argues that Darrow relates to an abrasion-resistant coating and that nowhere in the reference is there any suggestion in applying the abrasion-resistant coating to a machine part for a casting machine as in claim 1 or a molten aluminum alloy-contact member for a casting machine. However, Darrow teaches the same structural material as claimed including the steel base, Ni alloy layer and titanium carbide partially exposed on the surface. Since Applicant has not provided any limitations which would further define the structure of the machine part which is intended for use in a molten aluminum casting machine, the article of Darrow would be just as much of a machine part and capable for use in a casting machine as the part claimed by Applicant.

Applicant further argues that Darrow does not suggest that TiC particle repel molten aluminum alloy. However, since Darrow teaches the same materials having the same structure as the article claimed by Applicant, the aluminum repelling property would be the same as that claimed and thus meet the claim limitations.

Nakayama in view of Negishi References

Applicant argues that there is no suggesting in Nakayama that carbide particles are bonded on the surface of a nickel alloy layer. However, as set forth in the rejection

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above, Nakayama teaches that it is desirable to form a concentration gradient on the surface of the component wherein the carbides are in highest concentration at the surface which contacts the molten aluminum. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to have formed the surface having a high concentration of carbide particle so as to provide the composite with improved hardness and corrosion resistance. It is the position of the Examiner that such a formed article would contain carbide particles being partially exposed. In the alternative, it would have been obvious since it is known in the art to form surface layers of carbide particles to provide a layer made of high hardness materials such as titanium carbide which provides high abrasion resistance to the.

Applicant further argues that there is no suggestion that the TiC particles can repel molten aluminum alloy. However since Nakayama as modified by Negishi teaches the same materials having the same structure as the article claimed by Applicant, the aluminum repelling property would be the same as that claimed and thus meet the claim limitations.

Nakayama in view of Negishi References, further in view of Honma

Applicant argues that Honma does not teach or suggest the TiC particles are bonded to the surface. However as set forth above, this claim limitation is met by combination of the first two references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. SAVAGE whose telephone number is (571)272-1542. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Savage/
1-30-09

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